



Ralph E. Jocke  
Patent  
&  
Trademark Law

RECEIVED  
CENTRAL FAX CENTER  
NOV 07 2008

**FACSIMILE TRANSMISSION COVER SHEET**

TRANSMITTING: 18 PAGES (INCLUDING THIS PAGE)

TO : Mail Stop Appeal Brief - Patents  
Commissioner for Patents  
U.S. Patent and Trademark Office

TO FAX NUMBER: (571) 273-8300

SENDER: Ralph E. Jocke, Esq.

SENDER FAX NO.: (330) 722-6446

SENDER PHONE: (330) 721-0000

COMMENTS: Please file the attached Reply Brief in Application 09/086,857  
(Docket: D-1093)

If you do not receive all pages, contact the sender IMMEDIATELY at the number listed below.

The information contained in this facsimile message is confidential and intended only for the use of the individual or entity named above. If the reader of this message is not the intended recipient, you are hereby notified that any dissemination, distribution, or copying of this communication is strictly prohibited and will be considered as a tortious interference in our confidential business relationships. If you have received this communication in error, please immediately notify us by telephone and return the original message to us at the address below via the U.S. Postal Service. Thank you.

330 • 721 • 0000  
MEDINA

330 • 725 • 1669  
CLEVELAND

330 • 722 • 6446  
FACSIMILE

rej@walkerandjocke.com  
E-MAIL

231 South Broadway, Medina, Ohio U.S.A. 44256-2601

**RECEIVED**  
**CENTRAL FAX CENTER**  
**NOV 07 2008**

Walker  
&  
Jocke

a legal professional association

Ralph E. Jocke  
Patent  
&  
Trademark Law

November 7, 2008

Mail Stop Appeal Brief - Patents  
Commissioner for Patents  
PO Box 1450  
Alexandria, VA 22313-1450

Attn: Art Unit 3653  
Patent Examiner Michael E. Butler


Re: **Application No.:** 09/086,857  
**Confirmation No.:** 8855  
**Applicants:** David T. Frederick, et al.  
**Title:** Method For Tracking And Dispensing  
Medical Items From Environmentally  
Controlled Storage Area  
**Docket No.:** D-1093

Sir:


Please find enclosed a Reply Brief for filing in response to the Examiner's Answer dated September 8, 2008.

No fee is deemed required. However, the Commissioner is authorized to charge any necessary fee associated with this Reply Brief and any other fee due to Deposit Account 10-0637.

Very truly yours,

  
Ralph E. Jocke  
Reg. No. 31,029**CERTIFICATION UNDER 37 C.F.R. SECTIONS 1.8(a) AND 1.6(d)****FACSIMILE TRANSMISSION**

I hereby certify that, on the date shown below, this correspondence is being transmitted by facsimile to the Patent and Trademark Office at (571) 273-8300.

Date: Day 7 of November 2008  
Ralph E. Jocke330 • 721 • 0000  
MEDINA330 • 225 • 1669  
CLEVELAND330 • 722 • 6446  
FACSIMILErej@walkerandjocke.com  
E-MAIL

---

231 South Broadway, Medina, Ohio U.S.A. 44256-2601

RECEIVED  
CENTRAL FAX CENTER  
NOV 07 2008

D-1093

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE  
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES**

Previous Appeal No.: 2005-2434	)	
	)	
In re Application of: David T. Frederick, et al.	)	
	)	
Application No.: 09/086,857	)	Art Unit 3653
	)	
Confirmation No.: 8855	)	
	)	
Filed: May 29, 1998	)	Patent Examiner:
	)	Michael E. Butler
Title: System For Tracking And Dispensing	)	
Medical Items From Environmentally	)	
Controlled Storage Area	)	

Mail Stop Appeal Brief - Patents  
Commissioner for Patents  
PO Box 1450  
Alexandria, VA 22313-1450

**REPLY BRIEF PURSUANT TO 37 C.F.R. § 41.41**

Sir:

The Appellants hereby submit their Reply Brief pursuant to 37 C.F.R. § 41.41 concerning the above-referenced Application. The Reply Brief is in response to the Examiner's Answer ("Answer") dated September 8, 2008.

- 1 -

**Comments With Regard To The Appeal Conference**

Appellants respectfully submit that a proper appeal conference has not been conducted. The appeal rules require that the "two appeal conference participants *must* place their initials next to their name" (e.g., MPEP § 1207.01). The Answer at page 50 shows that only the conference participants "Michael E. Butler" and "Khoi Tran" have their initials properly located next to their name. The alleged conference participant "Joseph Thomas" does not have any initials next to his name. The alleged conference participant "Donald P. Walsh" does not have *his* initials next to his name. Thus, the Answer is *prima facie* defective and legally improper.

Furthermore, as best Appellants have been able to determine, Donald P. Walsh was not even employed by the Office at the time of the appeal conference, and thus could not have legally participated therein. In light of the nature of the situation, Appellants respectfully request evidence from the Office proving that the alleged two appeal conference participants indeed participated in the appeal conference. Appellants request that this evidence include their *written* signatures (as opposed to initials provided/typed by the Examiner) next to their name.

For the reason that the Answer is defective, and the many other reasons already noted (at page 2) in Appellants' Appeal Brief filed June 16, 2008 and Appellants' Request filed January 5, 2007, the current Examiner should be relieved of any responsibility for application prosecution. Appellants again request that this application be reassigned and docketed to a *primary* Examiner.

**STATUS OF CLAIMS**

Claims 1-50 are pending in the Application.

Claims rejected: 1-50

Claims allowed: none

Claims confirmed: none

Claims withdrawn: none

Claim objected to: none

Claims canceled: none

RECEIVED  
CENTRAL FAX CENTER  
NOV 07 2008

## GROUND OF REJECTION TO BE REVIEWED ON APPEAL

The questions presented in this appeal are:

1. Whether claims 27-43 are unpatentable under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which Appellants regard as the invention.
2. Whether claims 1, 3, 9, 24-25, 27, 31-33, 36-38, 42-44 and 49-50 are unpatentable pursuant to 35 U.S.C. § 102(b) as being anticipated by Lavigne, et al. (US 5,572,873) ("Lavigne").
3. Whether claims 1, 4, 12-15, 21, 24, 27-29, 31-33, 39, 41, 44, and 50 are unpatentable pursuant to 35 U.S.C. § 102(b) as being anticipated by Colson, Jr. et al. (US 5,520,450) ("Colson '450").
4. Whether claims 45, 48, and 50 are unpatentable pursuant to 35 U.S.C. § 102(b) as being anticipated by Pearson (US 5,562,232).
5. Whether claims 46, 48, and 50 are unpatentable pursuant to 35 U.S.C. § 102(e) as being anticipated by Higham et al. (US 5,805,456) ("Higham").

6. Whether claim 45 is unpatentable pursuant to 35 U.S.C. § 102(b) as anticipated by Colson, Jr. et al. (US 5,346,297) ("Colson '297").
7. Whether claims 2 and 26 are unpatentable pursuant to 35 U.S.C. § 103(a) as being unpatentable over Lavigne in view of Nemoto (US 4,237,439), Keskin, et al (US 5,894,277), and Tabata (US 4,656,850).
8. Whether claim 46 is unpatentable pursuant to 35 U.S.C. § 103(a) as being unpatentable over Higham.
9. Whether claims 1, 3, 24-26, and 41 are unpatentable pursuant to 35 U.S.C. § 103(a) as being unpatentable over Lavigne in view of Aten et al. (US 4,674,652) ("Aten").
10. Whether claims 1-3 and 24-25 are unpatentable pursuant to 35 U.S.C. § 103(a) as being unpatentable over Colson '450 in view of Lavigne.
11. Whether claims 45-47 and 49-50 are unpatentable pursuant to 35 U.S.C. § 103(a) as being unpatentable over Blechl et al. (US 5,377,864) ("Blechl") in view of Weinberger (US 5,408,443).
12. Whether claims 16-20 and 34-35 are unpatentable pursuant to 35 U.S.C. § 103(a) as being unpatentable over Lavigne in view of Engleson et al. (US 5,781,442) ("Engleson").

13. Whether claims 4-8 and 40 are unpatentable pursuant to 35 U.S.C. § 103(a) as being unpatentable over Colson '450 in view of Iwamoto et al. (US 5,575,515) ("Iwamoto").
14. Whether claim 23 is unpatentable pursuant to 35 U.S.C. § 103(a) as being unpatentable over Colson '450 in view of Warren (US 5,225,825).
15. Whether claims 9, 16-17, 20, 22, and 34-35 are unpatentable pursuant to 35 U.S.C. § 103(a) as being unpatentable over Colson '450 in view of Holmes (US 6,039,467).
16. Whether claims 9, 16-17, 20, 22, 34-35, and 42-44 are unpatentable pursuant to 35 U.S.C. § 103(a) as being unpatentable over Lavigne in view of Holmes.
17. Whether claims 45 and 49 are unpatentable pursuant to 35 U.S.C. § 103(a) as being unpatentable over Halvorson (US 4,847,764) in view of McDonald, et al. (US 5,314,243) ("McDonald").
18. Whether claims 46-47 and 49 are unpatentable pursuant to 35 U.S.C. § 103(a) as being unpatentable over Halvorson in view of Weinberger.
19. Whether claims 16-20 and 34-35 are unpatentable pursuant to 35 U.S.C. § 103(a) as being unpatentable over Colson '450 in view of Gombrich et al. (US 4,857,716) ("Gombrich").



20. Whether claims 4-11 and 21 are unpatentable pursuant to 35 U.S.C. § 103(a) as being unpatentable over Lavigne in view of Iwamoto.
21. Whether claims 11-15 and 23 are unpatentable pursuant to 35 U.S.C. § 103(a) as being unpatentable over Lavigne in view of Genest et al. (US 4,125,008) ("Genest").
22. Whether claim 41 is unpatentable pursuant to 35 U.S.C. § 103(a) as being unpatentable over Colson '450 in view of McDonald.
23. Whether claim 41 is unpatentable pursuant to 35 U.S.C. § 103(a) as being unpatentable over Colson '450 in view of Weinberger.
24. Whether claims 30 and 41 are unpatentable pursuant to 35 U.S.C. § 103(a) as being unpatentable over Colson '450 in view of Higham.

## ARGUMENT

### Appellants' Reply to the "Grounds of Rejection" section of the Answer

The grounds of rejection set forth in the Answer (at pages 3-5) are similar to the rejections previously made against these claims in the final rejection dated July 31, 2007, from which appeal was taken. However, a comparison of the rejections presented in the Examiner's Answer with the rejections pending at the time of the Appeal Brief (filed June 16, 2008 ) shows that certain rejections have been withdrawn by the Examiner. Appellants acknowledge the Examiner's withdrawal of the following rejections:

Claim 48 being anticipated by Lavigne.

Claim 49 being anticipated by Pearson.

Claim 48 being obvious over Blechl in view of Weinberger.

Claims 48 and 50 being obvious over Halvorson in view of McDonald.

Claims 45, 48, and 50 being obvious over Halvorson in view of Weinberger.

Appellants respectfully submit that the remaining rejections set forth in the Answer have already been fully addressed in Appellants' Appeal Brief filed June 16, 2008. Therefore, please note Appellants' previous arguments (in their Appeal Brief) regarding all the pending issues of record. Appellants' Appeal Brief filed June 16, 2008 is herein incorporated by reference.

**Appellants' Reply to the "Response to Argument" section of the Answer**

The Answer includes a "Response to Argument" section beginning on page 34. However, this section provides no new support for the rejections. Most of this section's "answer" consists of merely repeating allegations already presented in the "Grounds of Rejection" section of the Answer. The Examiner's comments in the sections entitled "Affidavit", "Declaration", and "Priority" are taken verbatim from the final Office Action dated July 31, 2007. Thus, Appellants respectfully submit that substantially all of the Office's alleged "answer" has already been fully addressed in their Appeal Brief.

The Answer does not treat each claim as a whole, but at best each claim feature is improperly considered in a vacuum. The Answer ignores the recited relationships among the many features. As a result, the Answer procedurally fails to establish a case of anticipation or obviousness. The Office still has not provided any factual support for the allegations of anticipation or obviousness. Furthermore, the "Response to Argument" section only addresses a portion of the many arguments made in the Appeal Brief in support of claim allowance.

The Examiner's comments in the Answer (at pages 37-39) with regard to Appellants' claim 24 not being entitled to an earlier date are misguided. For example, the Answer (on page 37) states that claim 24 has a lock module mounted to the exterior of a housing, and this specific feature is lacking in Appellants' parent applications. Yet the Examiner overlooks the fact that Appellants are entitled to the date indicated in the 37 CFR § 1.131 Declaration (filed September 27, 2000 ) for additional subject matter which would have been obvious to one having ordinary skill in the art (MPEP § 715.02). Appellants have shown in detail (e.g., Appeal Brief pages 24-25) that their claim 45 has support in parent patent 5,790,409. Claim 45 (like claim 24) also

recites a lock/housing relationship. Where does the Examiner ever state that it would *not* have been obvious to have had a lock module mounted to the exterior surface of a housing (as opposed to other housing surfaces)? He never does. Rather, the rejections speak otherwise. Claim 24 (like claim 45) is entitled to the critical date of March 7, 1994.

The Examiner (at Answer page 39) states that "Appellants assertion on page 28 of each element of claim 24 having support in parent patent 5,790,409 is clearly misleading, as no refrigeration is present in the parent". First, no such assertion can be found on page 28 of the Appeal Brief. Second, refrigeration is not in claim 24. Thus, the Examiner's statement is inapposite and moot.

The Examiner (at Answer page 38), as best understood, alleges that because of its priority claim, Colson '450 includes all of the subject matter disclosed in Colson '297. Appellants respectfully disagree. There is no evidence of record that Colson '450 incorporated by reference all of the subject matter disclosed in Colson '297. Note MPEP 201.06 (c) (IV). Regardless, because Colson '297 does not disclose or suggest the recited features (as explained in the Appeal Brief), Appellants do not need to swear behind the Colson '297 reference in order to establish patentability of the invention.

The Examiner (at Answer page 39), as best understood, alleges that Pearson '232 includes all of the subject matter disclosed in Pearson '029, which includes the features of claim 45. For reasons already discussed above with regard to "incorporation", Appellants respectfully disagree. Furthermore, Pearson '029 does not disclose the features of claim 45. If Pearson '029 had all of the features of claim 45 then it would have been applied thereagainst, because, as the

record indicates, the Examiner would not have missed the opportunity to make another cumulative rejection.

The Examiner's comments (e.g., Answer page 38) about each dependent claim having its own invention date, not including its base claim's subject matter, and not being allowable even if its base claim is allowable are unclear. It is well settled that "If an independent claim is nonobvious under 35 U.S.C. 103, then any claim depending therefrom is nonobvious" (MPEP § 2143.03). *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988).

The Answer at page 42 states that "Applicant has admitted via his restriction petition that his invention groups are not patentably distinct, so should the claims of be obviated upon any affirmation of the rejections claims of elected group I". This statement is unclear and nonsensical. Is the Examiner referring to the petition granted in the decision dated September 5, 2002, which ruled that "the restriction made by the examiner was improper"? As a result, there were never any valid "invention groups" to be either patentably distinct or not patentably distinct.

The Examiner's comments in the Answer at pages 41-48 are unclear. They are not specific to any claim or claim language. That is, the Examiner does not state which comments correspond to which claims. Appellants decline any invitation to guess such correspondence, if any. At best, the comments appear to be non directed, incoherent and not pertinent.

Furthermore, nowhere in the Answer does the Examiner (in response to Appeal Brief arguments) address the issue concerning the level of ordinary skill in the pertinent art at the time of Appellants' invention, as is required to sustain the rejections. Rather, the record shows that the obvious-type rejections are based on the opinion of the Examiner, which Appellants maintain is *not* a person of ordinary skill in the art. It follows that the rejections are legally improper.

The applicable legal standard for "obviousness" has not been met by the Office

For reasons previously discussed in the Appeal Brief, the Office has not made a *prima facie* showing of obviousness. Even in cases where the Office has made a *prima facie* showing of obviousness, a rejection cannot be properly made unless there is a requisite showing that it would be obvious to one having ordinary skill in the art to combine the features and relationships to produce the invention as claimed. In accordance with the dictates of the United States Supreme Court in *KSR International Co. v. Teleflex Inc.*, 127 S.Ct. 1727, 82 USPQ2d 1385 (2007), the determination as to whether there is a reason to combine features of prior art reference(s) must be evaluated through an analysis of the factors recited in *Graham v. John Deere*, 383 U.S. 1, 148 USPQ 459 (1966). The factual inquiries that must be made under *Graham* include:

- (a) determining the scope and content of the prior art,
- (b) ascertaining the differences between the prior art and the claims in issue,
- (c) resolving the level of ordinary skill in the pertinent art, and
- (d) evaluating evidence of secondary consideration.

Based on these required tests the claims should further be allowed.

The Office fails to present a proper *Graham* analysis

In accordance with the requirements of *Graham*, it is mandatory that before a claim can be rejected on the basis of obviousness, the Office is required to make a factual determination and resolve the level of ordinary skill in the pertinent art at the time that the invention was made. It is respectfully submitted that the Office has not made such a factual determination.

The rejections are not based on the opinion of one of ordinary skill in the art

The record shows that the reasons for modifying reference features in the rejections is based on the opinion of the Examiner. However, the record has not established the Examiner to be a person of ordinary skill in the art. Thus, it must be concluded that the basis for combining reference features in the rejections is *not* based on the opinion of a person of ordinary skill in the art. For this further reason, the rejections are respectfully submitted to be incorrect and should be reversed.

Additional Comments

It should be noted that the Answer points to the Examiner agreeing that a drawer comprises a door. Nowhere does the Examiner deny the correspondence. Even the rejections depend on the correspondence.

The strongest ("best") alleged rejections for each respective claim (as set forth at Answer pages 48-49) are unclear. For example, there is no pending rejection of claim 23 based on Lavigne in view of Warren. Nor is there any pending anticipation rejection of claim 26 based on Lavigne. Likewise, there is no pending anticipation rejection of claim 48 based on either Colson '297 or Colson '450.

Appellants respectfully submit that only the "best" rejection of each claim needs to be considered by the BPAI. If the *best* rejection of a claim is not sustainable, then it follows that the other (weaker) rejections thereof are even less sustainable. For the convenience of the BPAI, these "best" rejections (as indicated by the Examiner) have been outlined in a Rejection Table as follows:

<u>Claim</u>	<u>Rejection Type</u>	<u>Best Reference(s)</u>
1	102	Lavigne
2	103	Colson '450 in view of Lavigne
3	102	Lavigne
4	102	Colson '450
5-8	103	Lavigne in view of Iwamoto
9	102	Lavigne
10-11	103	Lavigne in view of Iwamoto
12	102	Colson '450
13-15	103	Lavigne in view of Genest
16-20	103	Lavigne in view of Engleson
21	102	Colson '450
22	103	Lavigne in view of Holmes
23	103	(unknown)
24-25	102	Lavigne
26	102	(unknown)
27	102	Lavigne
28-29	102	Colson '450
30	103	Colson '450 in view of Higham
31-33	102	Colson '450
34	103	Lavigne in view of Engleson
35	103	Colson '450 in view of Gombrich
36-38	102	Lavigne
39	102	Colson '450
40	103	Colson '450 in view of Iwamoto
41	103	Colson '450 in view of McDonald
42-44	102	Lavigne
45	103	Halvorson in view of McDonald
46	102	Higham
47	103	Halvorson in view of Weinberger
48	102	(unknown)
49-50	102	Lavigne



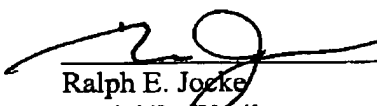
The Examiner's complaint (on Answer page 36) about "applicant's voluminous arguments" is duly noted. Appellants respectfully submit that they are merely responding to the cumulative multiple rejections. Even the BPAI stated (in the Remand dated June 12, 2006) that "The record in this application does not demonstrate any legitimate reason for the examiner to have entered the large number of prior art rejections that are currently standing. Indeed . . . the multiple rejections . . . are merely cumulative". In other words, the Examiner has no reason to complain, but is rightfully reaping what he alone has sown. Appellants apologize to the BPAI for any additional burden placed thereon as a result of Appellants' duty to respond to the rejections.

RECEIVED  
CENTRAL FAX CENTER  
NOV 07 2008

### CONCLUSION

Each of Appellants' pending claims specifically recites features and relationships that are neither disclosed nor suggested in the applied prior art. The Office has not established a *prima facie* case of obviousness. Furthermore, the record is absent a teaching, suggestion, motivation, or valid reason for one of ordinary skill in the art to have produced the recited invention. Appellants' claims patentably distinguish over the applied references. For these reasons it is respectfully submitted that all the pending claims are allowable.

Respectfully submitted,



Ralph E. Jocke  
Daniel D. Wasil  
WALKER & JOCKE  
231 South Broadway  
Medina, Ohio 44256  
(330) 721-0000

Reg. No. 31,029  
Reg. No. 45,303